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Paul Habermann

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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCESAppeal 2008-1720
Applications 09/664,326
Technology Center 1600

Oral Hearing Held: June 12, 2008

Before TONI R. SCHEINER, MELANIE L. McCOLLUM, and
DEMETRA J. MILLS, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

CARLOS M. TELLEZ, PH.D., ESQ.
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The above-entitled matter came on for hearing on Thursday, June 12, 2008, commencing at 9:25 a.m., at the U.S. Patent and Trademark Office, 30600 Dulany Street, 9th Floor, Hearing Room A, Alexandria, Virginia, before Kevin Carr.

P R O C E E D I N G S

THE USHER: Calendar Number 17, Mr. Tellez.

JUDGE SCHEINER: Thank you. Good morning.

1^o MR. TELLEZ: Good morning.

2 JUDGE SCHEINER: Take whatever time you need to get set up and
3then you'll have 20 minutes to present your argument.

4 MR. TELLEZ: I'm ready whenever you are.

5 JUDGE SCHEINER: I think we're ready, too.

6 MR. TELLEZ: Okay. My name is Carlos Tellez. I am here on behalf
7of Sanofi Aventis. And, as you know, the only issue here is a written
8description rejection. The independent claim is directed to a method or a
9process selecting a signal peptide for secretory expression in *e.coli* and the
10limitation. And the limitation at issue here is wherein the *e.coli* bacteria are
11not *e. coli* secretor mutants.

12 We believe there is proper description for that limitation, because the
13specification expressly indicates that experiments with both types of strains,
14no secretor and secretor mutants were performed and that were just coming
15out the matter directed to the secretor mutants in a classic In re Johnson
16provision.

17 I can direct you to the section of the specification. It's page 9, lines 1
18through 6, that describes the experiments where both *e. coli* strain Mc 1061
19or the secretor mutant WCM100 were transformed with the ligation mixture
20and grown. Under suitable conditions that experiment clearly demonstrated
21that both types of strain secretor and non-secretor mutants were used. We're
22now carving out the subject matter of the secretor mutants.

23 JUDGE SCHEINER: So is it fair to say that your position is that
24you're excluding something that was specifically enumerated?

25 MR. TELLEZ: Correct.

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1 JUDGE SCHEINER: Was there an issue about the scope, whether or
2not you had basis to exclude the generic category of secretor mutants?

3 MR. TELLEZ: Well, I don't believe the examiner raised that issue,
4but if you're asking me, I believe that all of the secretor mutants will behave
5in a similar manner. So WCM100 will be a representative secretor mutant.
6And, in fact, I think both types of e. coli cells secreted on most secretor
7mutants will behave in the same manner in this experiment.

8 I don't think there are any differences between how a secretor mutant
9or a non-secretor mutant will perform with respect to the method that is
10being claimed.

11 JUDGE SCHEINER: I think this may be the shortest oral hearing on
12record. Unless you have something further, I think you've covered
13everything.

14 MR. TELLEZ: Yes, I mean, that's basically our argument.

15 JUDGE SCHEINER: Okay.

16 MR. TELLEZ: Unless you have further questions?

17 JUDGE SCHEINER: Do you have anything?

18 JUDGE MCCOLLUM: I don't think I do.

19 JUDGE MILLS: No questions.

20 JUDGE SCHEINER: I don't have anything further.

21 MR. TELLEZ: Okay, well, thank you very much. I appreciate your
22time.

23 JUDGE SCHEINER: I mean you have more time if you care to use it,
24but I think you've covered everything.

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16 MR. TELLEZ: I think so, too.

17 JUDGE SCHEINER: Okay. Thank you for coming in.

18 MR. TELLEZ: Thank you.

19 [Whereupon, at 9:31 a.m., the hearing was concluded.]

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